

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Peter Gerrard, et al.  
Appl. No.: 10/660,810  
Conf. No.: 7059  
Filed: September 11, 2003  
Title: GAMING DEVICE HAVING A MULTIPLE ACCUMULATED SYMBOLS GAME  
Art Unit: 3714  
Examiner: Christian E. Rendon  
Docket No.: 112300-1633

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

This request and the following remarks are submitted in response to the interpretation of the prior art maintained in the May 28, 2008 Final Office Action, which Applicant respectfully believes rises to the level of clear error, making the case proper for pre-appeal review. This request is filed contemporaneously with a form PTO/SB/33, "Pre-Appeal Brief Request for Review" and a form PTO/SB/31, "Notice of Appeal." Please charge Deposit Account No. 02-1818 for the Notice of Appeal and any other fees due.

Claims 1 to 56 are pending. The Examiner rejected Claims 1 to 7, 9 to 14, 16 to 21, 23 to 28, 30 to 33, 35 to 40, 42 to 47, and 49 to 54 under 35 U.S.C. § 103(a) as being unpatentable over GB 2353128A to Claypole ("Claypole") in view of U.S. Patent No. 6,843,721 to Vancura ("Vancura").

Claypole discloses a wagering game having three reels which each have a plurality of symbols. Three paylines are associated with the reels. Each payline is associated with a separate trail. Some of the symbols on the reels are associated with one or more points. For each payline, if such symbols are generated along the payline, the indicator moves along the trail associated with the payline base on the points associated with the symbols. After the player

makes a wager, the reels spin and display symbols along the paylines. If a winning combination of symbols is displayed on any of the paylines, the gaming device awards the player a prize associated with the combination of symbols indicated on the payline. Any points associated with the symbols displayed on a payline contribute to moving the indicator along the trail associated with that payline. Claypole further includes a top game associated with a track having plurality of positions, each of the positions associated with an outcome. The player presses a “gamble” button to move an indicator around the track. Each time the player presses the gamble button, the indicator can land on different possible outcomes, including: (1) positive outcomes, which cause the player to win points for further advancement along one or more of the trails; (2) bonus outcomes, which enable the player to play a bonus game; and (3) negative or lose outcomes, which cause the player to lose the points accumulated along one or more of the trails. The player may decide at any time to stop pressing the gamble button and press the “collect” button to cash out.

Vancura discloses a bonus game which offers a player a plurality of objects, each having a probability of success and an associated award. The player chooses an object and receives the associated award if the chosen object is successful. The player continues to choose objects until the game ends. The game may end randomly after each object is chosen, upon all chosen objects resulting in success, or upon the player choosing a fixed number of objects.

The Examiner acknowledges that Claypole is silent regarding how the game ends. The Examiner relies on the Vancura reference for its teaching of a bonus game that ends randomly after each player choice of an object. The Examiner concludes that it would have been obvious to incorporate this feature of Vancura into Claypole to further increase the strategic difficulty of the game. The Examiner further asserts that it is pretty obvious that once a game ends all of the accumulated lights would reset to allow the next player a chance to play the game their own way.

Unlike the gaming device of independent Claim 1, the gaming device resulting from the combination of Claypole and Vancura would not include a

processor programmed for the single play of the game to: (a) cause the indicator generator to generate and associate a number of indicators with each of the award groups, (b) for each of the award groups, accumulate a quantity of indicators corresponding to the number of indicators that is associated with that award group by the indicator generator, (c) repeat (a) to (b) until all of the indicators have been accumulated in at least one of the award groups; (d) when all of the indicators have been accumulated in at least one of the award groups: (i) provide to the player the awards associated with any award groups in which all of the indicators have been accumulated, (ii) randomly determine whether to end the single play of the game, and (iii) if it is determined not to end the single play of the game, reset the indicators in the award groups associated with the awards provided to the player, and (e) repeat (a) to (d) until it is determined to end the single play of the game.

In a play of the Claypole game, the reels are activated upon a wager and display symbols along the paylines. If a winning combination is indicated on any of the paylines, the gaming device awards the player any prize associated with the indicated combination. In addition, any points associated with the symbols displayed on a payline contribute to moving the indicator along the trail associated with that payline. If the player wishes to continue advancing up one or more of the trails (e.g., in an attempt to accumulate all of the positions of the trail), the player must place another wager to initiate a subsequent play of the game to potentially win further moves up one or more of the trails. In this manner, Claypole provides a persistence type game, in which a player progresses along the trails over a plurality of plays of the wagering game. The player must place a wager for each spins of the reels. It appears to require several plays of the wagering game (i.e., several reel spins) and, thus, several wagers for the player to accumulate all the positions of one or more of the trails. The Examiner's statements support this requirement of Claypole. Page 3 of the May 28, 2008 Final Office Action states that "Claypole is silent regarding how the game ends, leaving one of ordinary skill to assume that a player can attempt to

collect all future possible bonuses until he or she loses enough interest or money to stop.”

Claypole does not disclose, in a single play of the game, causing the indicator generator to generate and associate a number of indicators with each of the award groups, (b) for each of the award groups, accumulating a quantity of indicators corresponding to the number of indicators that is associated with that award group by the indicator generator, and (c) repeating (a) to (b) until all of the indicators have been accumulated in at least one of the award groups. If that were the case, then every time a player made a wager to play the Claypole game, the player would accumulate all of the positions of at least one of the trails and, as a result, win the ultimate award associated with that trail.

Furthermore, Claypole does not disclose, when all of the indicators have been accumulated in at least one of the award groups, randomly determining whether to end the single play of the game, and if it is determined not to end the single play of the game, resetting the indicators in the award groups associated with the awards provided to the player and repeating (a) to (d) until it is determined to end the single play of the game.

The Examiner states that it is *pretty obvious* that once a game ends, all of the accumulated lights would reset to allow the next player a chance to play the game their own way. This is not relevant to the claimed invention. In Claim 1, if it is determined not to end the single play of the game, the processor is programmed to reset the indicators in the award groups associated with the awards provided to the player, and repeat (a) to (d) until it is determined to end the single play of the game. Thus, if the determination is made not to end the single play of the game, the award groups associated with awards that were provided to the player are reset, and the same play of the game continues. That is, the same player can continue accumulating indicators to obtain further awards in the same, single play of the game without having to place a further wager.

Combining Claypole and Vancura in the manner proposed by the Examiner does not achieve the gaming device of Claim 1, and the rejection of Claim 1 is clearly in error. Independent Claim 17 includes certain similar

elements to Claim 1. For similar reasons, the rejection of Claim 17 is clearly in error.

The rejection of independent Claim 30 is clearly in error for reasons similar to those discussed above. More specifically, unlike the gaming device of Claim 30, the gaming device resulting from the combination of Claypole and Vancura does not include a processor programmed for the single play of the game to: (a) cause the indicator generator to generate and associate a number of indicators with each of the award groups, (b) accumulate a quantity of indicators in each of the award groups corresponding to the number of indicators associated with that award group by the indicator generator, (c) repeat (a) to (b) until all of the indicators have been accumulated in at least one of the award groups; (d) when all of the indicators have been accumulated in at least one of the award groups: (i) indicate the awards associated with any award groups in which all of the indicators have been accumulated, (ii) randomly determine whether to provide any of the indicated awards to a player, (iii) if it is determined not to provide the indicated awards to the player, reset the indicators in the award groups associated with the indicated awards and cause the indicator generator to generate and associate one of said number of indicators with each of the award groups, and (iv) if it is determined to provide the indicated awards to the player, provide any indicated awards to the player.

Independent Claim 43 includes certain similar elements to Claim 30. The rejection of Claim 43 is also clearly erroneous for similar reasons. Accordingly, independent Claims 1, 17, 30, and 43 and the claims which depend therefrom are in condition for allowance.

Respectfully submitted,

Bell, Boyd & Lloyd LLP  
BY:   
Adam H. Masia  
Reg. No. 35,602  
Customer No. 29159

Dated: August 28, 2008

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

112300-1633

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/660,810

Filed

September 11, 2003

First Named Inventor

Peter Gerrard

Art Unit

3714

Examiner

Christian E. Rendon

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record. 35,602  
Registration number \_\_\_\_\_

attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

Adam H. Masia

Typed or printed name

(312) 807-4284

Telephone number

August 28, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**